

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application with useful, concrete and tangible result.

Regarding claim 1, it recites an apparatus for information processing comprising an idea generation support section. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment, or machine which would result a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Because an "idea generation support section" can be reasonably interpreted as referring to lines of programming with the software apparatus rather than referring to an apparatus as a physical object. Therefore, the claimed subject is rejected under 35 U.S.C. 101 for being software per se. "Software per se" is

non-statutory under 35 USC 101 because it is merely a set instruction without any defined tangible output or tangible result being produced. The requirement for tangible result under 35 USC 101 is defined in *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47USPQ2d 1596 (Fed. Cir. 1998). Therefore, claim 1 recites non-statutory subject matter.

Similarly, the limitations in claims 2-10 don't claim any specific hardware and are therefore software per se, and they are rejected with the same rationale applied against claim 1 above.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3 and 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al (US 2003/0036947).
4. Per claim 1, Smith discloses an apparatus for information processing comprising an idea generation support section configured (Smith paragraph [0071]: lines 1-10): to relate unit information of needs of a supplier (Smith paragraph [0024]: lines 3-5) of a product and unit information of needs of a user (Smith paragraph [0024]: lines 3-5) to predetermined comment code (Smith fig. 13: element 208, code "7340" as an example);

to relate unit information of seeds of the product (Smith paragraph [0032]: lines 5-9) required from the needs of the supplier and the needs of the user to the comment code (Smith fig. 13: element 208, code "7340" as an example); and to summarize the unit information of the needs of the supplier, the unit information of the needs of the user, and the unit information of the seeds of the product by using the comment code (Smith fig. 13: element 216, "idea summary").

5. Per claim 2, Smith discloses the apparatus of claim 1, wherein the comment code is a code (Smith fig. 13: element 208, code "7340" as an example) rendered as indexes of one or more of the product configuration elements that is an attribute, an advantage, and a target of each of the unit information (Smith paragraph [0099]: lines 3-14).

6. Per claim 3, Smith discloses an apparatus for information processing comprising: a research section extracting a first key word from target information to be searched (Smith paragraph [0038]: lines 1-4), and searching for relevant information for regard to the first keyword from searching target information (Smith paragraph [0097]: lines 1-6); an assessment analysis section receiving a correlation between the target information to be searched including a using possibility of the relevant information for the target information to be searched and the relevant information (Smith paragraph [0100]: lines 1-16); and a document generation section generating a document from the target information to be searched and the relevant information on the basis of the correlation received by the assessment analysis section (Smith paragraph [0102]: lines 1-16).

7. Note that claim 14 recites the same limitations as claim 3 and is rejected accordingly.

8. Per claim 11, Smith discloses a method for information processing comprising: pursuing needs of a supplier for a product (Smith paragraph [0024]: lines 3-5); pursuing needs of a user for the product (Smith paragraph [0024]: lines 3-5); and pursuing seeds of the product to be realizable from the needs of the supplier and the needs of the user (Smith paragraph [0032]: lines 5-9).

9. Per claim 12, Smith discloses a method of claim 11, further comprising relating predetermined comment code to unit information of the needs of the supplier, unit information of the needs of the user, and unit information of the seeds of the product (Smith fig. 13: element 208, code "7340" as an example);; and summarizing each unit information by the related comment code (Smith fig. 13: element 216, "idea summary").

10. Per claim 13, Smith discloses a method of claim 11 or 12, wherein the comment code is a code rendered as indexes of one or more of the product configuration elements that is an attribute, an advantage, and a target of each of the unit information (Smith paragraph [0099]: lines 3-14).

11. Claims 6, 7, 17, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Komamura, Noruyiki (US 2004/0249790).

12. Per claim 6, Komamura discloses an apparatus for information processing comprising a research section configured (Komamura paragraph [0008]: lines 1-2): to extract a first key word from target information to be searched (Komamura paragraph

[0008]: lines 2-3); to search for relevant information for regard to the first keyword from searching target information (Komamura paragraph [0008]: lines 3-7); to extract a second key word for characterizing the relevant information (Komamura paragraph [0008]: lines 7-16); and to summarize the relevant information by summary item including one or more of the first key word and the second key word (Komamura paragraph [0008]: lines 16-17).

13. Note that claim 17 recites the same limitations as claim 6 and is rejected accordingly.

14. Per claim 7, Komamura discloses the apparatus of claim 6, wherein in the research section, adistributionmap for indicating i0 the relation between the summarized relevant information and the summary item is generated (Komamura paragraph [0137]: lines 1-8).

15. Note that claim 18 recites the same limitations as claim 7 and is rejected accordingly.

16. Claims 9, 10, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Nosohara, Makifumi (US 6571241)

17. Per claim 9, Nosohara discloses an apparatus for information processing comprising a foreign document analysis section configured: to compare searching target information (Makifumi fig. 5: elements S501, S502, S504); to compares words used by each country (Makifumi fig. 12B: element 1202); and to generate translation with an original in each country corresponding to the words, in same searching target

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information by contents described by using language in each country (Makifumi col. 3: lines 8-14).

18. Note that claim 20 recites the same limitations as claim 9 and is rejected accordingly.

19. Per claim 10, Nosohara discloses an apparatus for information processing comprising a research section configured: to extract a first the key word from target information to be searched; to translate the first key word into a prescribed language (Nosohara col. 13: lines 32-37); and to search for relevant information for regard to the translated first key word from searching target information (Nosohara col. 13: lines 37-39).

20. Note that claim 21 recites the same limitations as claim 10 and is rejected accordingly.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 2003/0036947) in view of Takano et al (US 6434580).

23. Per claim 4, Smith discloses the apparatus of claim 3, wherein the correlation of the assessment analysis section further includes at least one or more of among "None

assessment", "Whether or not requirement to pursuit research", "Right or wrong of diverting to proposals information", and "Relevancy with information of the specification filed patent application" (Smith paragraph [0102]: lines 16-19).

Smith fails to disclose where the searching target information is information of a specification filed patent application, and the generated document is a specification to be filing patent application.

Takano teaches where the searching target information is information of a specification filed patent application (Takano col. 3, lines 14-19), and the generated document is a specification to be filing patent application (Takano col. 3, lines 19-24).

Thus it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to implement the teachings of Takano into Smith since Smith suggests searching target information and generating document in general and Takano suggests in particular searching filed patent application and generating draft specification for patent application to be filed because it reduces the searching time to obtain the relevant information significantly.

24. Note that claim 15 recites the same limitations as claim 4 and is rejected accordingly.

25. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al (US 2003/0036947) in view of Nosohara, Makifumi (US 6571241).

26. Per claim 5, Smith discloses the apparatus of claim 3, but fails to disclose wherein in the research section, the first key word is translated into a prescribed language, and the relevant information for regard to the first key word translated from the searching target information is searched.

Nosohara teaches wherein in the research section, the first key word is translated into a prescribed language, and the relevant information for regard to the first key word translated from the searching target information is searched (Nosohara col. 13: lines 32-39).

Thus it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to implement the teachings of Nosohara into Smith since Smith suggests searching using keyword in general and Nosohara suggests in particular the importance of conducting search by translating keyword into a language where the patent information is available because this makes it easy for users to access a patent databases available in different languages (Nosohara col. 2: lines 15-19).

27. Note that claim 16 recites the same limitations as claim 5 and is rejected accordingly.

28. Claims 8 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over Komamura, Noruyiki (US 2004/0249790) in view of Takano et al (US 6434580).

29. Per claim 8, Komamura discloses the apparatus of claim 6, but fails to disclose wherein in the case where the searching target information is information of a

specification filed patent application, the summary item further includes one or more of among patent classification, an application year, an applicant, and an inventor.

Takano teaches wherein in the case where the searching target information is information of a specification filed patent application, the summary item further includes one or more of among patent classification, an application year, an applicant, and an inventor (Takano col. 16, lines 59-65).

Thus it would have been obvious, to one of ordinary skill in the art, at the time the invention was made to implement the teachings of Takano into Komamura since Komamura suggests using patent information in general and Takano suggests in particular using patent application information in conducting prior art search because it enables users to obtain relevant information easily (Takano col. 1: lines 59-67).

30. Claim 19 is analyzed and discussed with respect to claim 8 above and is rejected accordingly.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANTENEH GIRMA whose telephone number is (571)270-5242. The examiner can normally be reached on M-F 7:30am-5pm EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj Kumar can be reached on (571) 272-3011. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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